

REMARKS/ARGUMENTS

Claim Rejections under 35 U.S.C. § 103

The examiner has rejected claims 1-7, 10 and 17-18 35 U.S.C. § 103(a) as being obvious over Boston, et al. (U.S. 6,076,079) (hereinafter "Boston") in view of Terriss, et al. (U.S. 5,964,823) (hereinafter "Terriss") in further view of Ilium Software ("TipsterTM") (hereinafter "Ilium Software"). As noted by the examiner, 35 U.S.C. 103(a) states that:

a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Therefore, applicant's invention, as claimed, will be unpatentable if the differences between the rejected claims and the combined knowledge disclosed in the patents granted to Boston and Terriss, and the Ilium Software disclosure are such that applicant's invention would have been obvious.

With respect to claim 1, the examiner has alleged that Boston discloses a tips calculator comprising a base member having a face side having at least one display screen for displaying a bill amount, a tip amount, a tip percentage and a total amount. However, Boston does not disclose these features. Boston discloses a main display that displays the amount of the bill, and additional displays for displaying the tip percentage, tip amount, and total. Boston, Fig. 1-2, col. 4, lines 12-13; col. 4, lines 42-55; col. 5, lines 3-5, col. 5, lines 7-9; col. 5, lines 14-17. Additionally, the main display of Boston is found only on the first side, whereas the additional displays are limited to the second side

location. Even where the claims of Boston seem to limit the device to a single display (as in claim 1), that display is on the "second side of said housing for displaying said percentage value." Boston, col. 6, lines 7-8. Therefore, Boston does not disclose a main display area that displays a bill amount, a tip amount and a total amount.

Additionally, contrary to the examiner's assertions, Boston does not disclose a second grouping of buttons for designating tip amounts as percentages. Boston discloses merely two preprogrammed tip amount buttons, preferably preset to 15% and 20 %, and increment buttons. Specifically, Boston discloses that "the second side 18 contains fifth 27, sixth 29, seventh 30 and eighth 32 calculating device control means." Boston, col. 4, lines, 38-41. The increment buttons do only that, increment the percentage up or down one integer value. Applicant's device has individual buttons corresponding to different percentages. One key difference then, is that applicant's device requires only a single push of a button to obtain a tip amount. The act of pushing an increment button performs a very different function; it adds or subtracts "1" from the current tip percentage. Therefore, it can not be rightly said that Boston discloses any more than two tip percentage buttons.

Also, Boston does not disclose a Total Button, nor is the total amount displayed on the main display area. The examiner's citation to Boston, col. 2, lines 35-41 further supports this, in that it shows that "a *third* display screen shows the amount of the tip calculated by the processor circuitry." (emphasis added). Figures 1 and 2 of Boston further support that multiple display screens are necessary, and at the very least, that a single main display screen is not disclosed.

Terriss, does indeed disclose mathematical functions, however, this addition is not enough to overcome the shortcomings of the Boston disclosure. Therefore, the combination of the two do nothing to render applicant's device obvious.

The Ilium Software disclosure likewise can not serve to correct the deficiencies in the Boston disclosure. The Ilium Software disclosure does disclose a software program, that when used in conjunction with a commercially available device, such as a PalmTM or Pocket PC, includes means for calculating individual shares of a total bill amount. However, the Ilium Software disclosure fails to disclose a *group* of buttons that allows the user to input the number of members of a party with a single touch. As noted above, an increment button does not substitute for a button that designates, and is programmed with, a specific whole number.

Additionally, there are no buttons at all on the devices that utilize the Ilium Software as can best be determined from the limited nature of the citation. Disclosure of these devices have not been cited against the applicant, presumably because they are so different as to not contribute to an obviousness determination. It is common knowledge within the art, however, that a device that uses the Ilium Software at issue, such as a PalmPilotTM, comprises a single display that a user interacts with through a pressure sensitive screen or the like. Therefore, the differences between the Ilium Software disclosure and applicant's device show the lack of motivation to combine it with the other cited references. Additionally, the Ilium Software disclosure is merely software, and is incompatible with the devices cited as prior art, thereby rendering any combination inoperable. An inoperable combination can not be said to render applicant's device obvious.

Further, it is unclear as to the date of the Ilium Software disclosure as prior art, and applicant contends that the Ilium Software disclosure does not antedate applicant's invention date. As noted previously, even if it does, and there is no evidence suggesting that this is the case, the Ilium Software disclosure can not render applicant's invention obvious with the addition of features to a critically flawed disclosure by the Boston patent.

With respect to claims 2-4 Boston does indeed disclose the noted features. But these claims are dependent on claim 1, and applicant has shown that claim 1 is not obvious over the combination of the cited prior art. As such, none of these dependent claims can be considered obvious, as they depend from a non-obvious claim.

Similar to claims 2-4, claim 5 is dependent on claim 1, and applicant has shown that claim 1 is not obvious over the combination of the cited prior art. As such, claim 5 can not be considered obvious, as it depends from a non-obvious claim.

With regard to claim 5, Boston suggests other common percentage amounts could be used, but as previously mentioned, this would still only be on the two percentage buttons present on that device. There is nothing in Boston suggesting the inclusion of additional buttons for additional percentages similar to applicant's invention. Boston specifically discloses that the "preprogrammed percentage amounts are fifteen (15) percent and twenty (20) percent . . . [however], other percentage amounts may be used." Boston, col. 4, lines 56-60. The language is unambiguous; the "other percentage amounts" refer to the two preprogrammed buttons, not the addition of more preprogrammed buttons. Therefore, claim 5 can not be considered obvious in light of the disclosure provided by Boston, because Boston contemplates merely switching the

percentages on the two preprogrammed buttons that are present, while applicant's invention includes "buttons designating tip amounts as percentages of the bill amount in one percent increments and in a range from 10 percent to at least 25 percent." Applicant's Specification, claim 5.

Similar to claims 2-5, claim 6 is also dependent on claim 1, and applicant has shown that claim 1 is not obvious over the combination of the cited prior art. As such, claim 6 can not be considered obvious, as it depends from a non-obvious claim.

With regard to the specifics of claim 6, applicant refers to the arguments made above with respect to the Ilium Software disclosure. The Ilium Software disclosure does not antedate applicant's invention. Additionally, the Ilium Software disclosure does not provide enough information concerning the devices to present a case for obviousness. Applicant again points to the fact that the Ilium Software disclosure is for a software program that may be used with certain handheld devices, namely the PalmPilotTM. There is no disclosure concerning the actual devices embodying the software, other than two figures displaying what these device displays might look like. In other words, this reference is either non-enabling, or simply lacks the features upon which the examiner relies for the obviousness rejection. Either situation dictates a finding of nonobviousness.

With regard to claim 7, the examiner claims that the Ilium Software disclosure teaches a Share Button, and then cites as an example the "tip button." There can be no doubt that this is simply not true. The lack of any specifics in the Ilium Software disclosure notwithstanding, the tip button is not in any way similar to a Share Button in function or structure. Structurally, as previously mentioned, the Ilium Software disclosure shows only a pressure sensitive screen, not buttons. Functionally, the Tip

"button" of the Ilium Software disclosure presumably does one thing, it calculates the tip. In all likelihood, the individual share is not calculated until the increment buttons are utilized to increase the number of members of the party. Until that happens, there would be no cause to display each member's share. At best, the Ilium Software disclosure is unclear. In any event, the Ilium Software disclosure teaches away from a separate Share Button, that is in addition to the Tip Button, as disclosed by applicant.

With regard to claim 10, it should hopefully now be clear that the Ilium Software disclosure can not function as a reference supporting a claim for obviousness. However, even if it could, the examiner points to the increment "buttons" (up and down arrows) as disclosing applicant's buttons designating the number of members in the group as whole sequential numbers from 2 up to at least 12. The arrow "buttons" do not comprise, nor do they teach, buttons designating number of members in the group as whole sequential numbers from 2 up to at least 12. All that could be said in this instance is that the Ilium Software disclosure teaches the addition of two arrow "buttons." This is not the same as teaching whole sequential numbers from 2 up to at least 12, and therefore, this does not render applicant's device obvious. Whether adding the Ilium Software disclosure to Boston would make it easier and more convenient does not bear on the issue of obviousness.

The shortcomings mentioned previously are sufficient to show why claim 17 is not rendered obvious by the addition of the Ilium Software disclosure to Boston and Terriss. It is illogical to argue that up and down arrows teach "buttons designating numbers of members in a group as whole sequential numbers." Applicant, claim 17. All that the "buttons" of the Ilium Software disclosure designate, are up and down arrows,

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nothing more. It is inapposite whether after employing the up and down arrows a secondary meaning, i.e. member number, is arrived at. A button with the number "9" on it is not the same as a button with an arrow on it. As a result, claim 17 is not rendered obvious by any combination of the cited prior art.

With respect to claim 18, applicant responds to the rejection under the same rationale as cited in the response to the rejection of claim 7.

With respect to claim 16, applicant refers back to the rational of the various rejections above, specifically, the response to the rejection of claim 1, et al. The reasons mentioned above include, but are not limited to the fact that Boston does not display its various results on a single main display; Boston does not teach the use of a Total Button, and Boston does not disclose a plurality of Tip Percentage buttons. As a result, the combination of Boston and Terriss can not render applicant's method, as claimed in claim 16, obvious.

The rejection of claim 11 can be responded to by referring back to the response to claim 1 above. Therefore, the addition of Lipton (U.S. Patent No. 4,988,025) does nothing to correct the many deficiencies previously cited in the prior art disclosures

Reconsideration and further examination is respectfully requested. The Commissioner is hereby authorized to charge any additional fees which may be required for this amendment, or credit any overpayment to Deposit Account No. 12-0115.

In the event that an extension of time is required to file this response, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an

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extension of time or credit any overpayment for an extension of time to Deposit Account
No. 12-0115.

Applicant has made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Patrick D. Archibald, Applicant's Attorney at (617) 720-0091 so that such issues may be resolved as expeditiously as possible.

For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,

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